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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,926	11/26/2003	Richard F. Boehme	YOR920030420US1	1895
29683 7590 02/09/2009 HARRINGTON & SMITH, PC 4 RESEARCH DRIVE, Suite 202 SHELTON, CT 06484-6212				
EXAMINER				
McCORMICK, GABRIELLE A				
ART UNIT		PAPER NUMBER		
3629				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/722,926

**Applicant(s)**

BOEHME ET AL.

**Examiner**

Gabrielle McCormick

**Art Unit**

3629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-85/86)
- Paper No(s)/Mail Date 3/3/2004.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the application and preliminary amendment filed on November 26, 2003 and March 12, 2008.
2. Claim 41 has been added.
3. Claims 1-40 have been canceled.
4. Claim 41 is currently pending and have been examined.

### ***Information Disclosure Statement***

5. The Information Disclosure Statement filed on March 3, 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Drawings***

6. The drawings are objected to because handwritten annotations are used to reference the features of the figures. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 41 is rejected as being directed to non-statutory subject matter. Claim 41 is a method claim that recites process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See Flook, 437 U.S. at 590).
9. Claim 41 does not recite the use of any machine implementation; rather, it recites method steps that can be implemented by a human being. Though the claim recites "inputting a machine readable representation of assessment input information" and "mapping said assessment input information", this could be broadly read such that a paper form encompassing the rubric criteria and scoring guidelines is filled out (i.e., mapped) by hand. Scanning technology can convert all the information on the paper (including the handwritten portions) into an electronic version (i.e., a PDF), thus the handwritten information is "machine readable".
10. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claim 41 fails that test and is therefore rejected under 35 USC 101.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claim 41** is rejected under 35 U.S.C. 103(a) as being unpatentable over Stone Middle School ("Automating Authentic Assessment with Rubrics" retrieved from the Internet Archive at <http://web.archive.org/web/20021120071617/http://stone.web.brevard.k12.fl.us/html/comprubric.html> and <http://web.archive.org/web/20021109142902/stone.web.brevard.k12.fl.us/html/teacheval.html>, hereinafter referred to as "Stone") in view of Trenholm et al. (US Pat. No. 6,120,299, hereinafter referred to as "Trenholm").

13. **Claim 41:** Stone discloses

- *selecting a rubric having associated rubric information, where said rubric information includes at least one benchmark, at least one criteria associated with each said at least one benchmark, and at least one score associated with each said at least one benchmark;* (pg. 3; "One Solution...": the rubric is defined to include a scoring guide for behaviors (i.e., benchmarks) that respond to the same prompt (i.e., criteria) and pg. 4; "Recommendations...": "Use rubric for an evaluation of an presentation or activity", thus, a rubric is selected for use.)
- *inputting a machine readable representation of assessment input information associated with an entity, said assessment input information comprising an identification of a combination of the entity, an input type and the rubric;* (pg. 4; "Rubric...": "Recording performance can be simplified with computerized form", thus machine-readable representation of assessment input information is inputted and pg. 4; "Utilizing...": "Following the activity or performance an

individualized report to each student is easily printed with the students own score in each field", thus the information is inputted such that a combination of the entity (each student) and the rubric is made. The input type is inherently associated as the information is inputted into the computerized form.)

- *mapping said assessment input information to said rubric information to yield results of said mapping and;* (pg. 4; "Utilizing...": "Following the activity or performance an individualized report to each student is easily printed with the students own score in each field", thus the "report" contains the mapped information.)
  - *storing said results of said mapping;* (pg. 4; "Utilizing...": In order to create the "individualized report", the results of the mapping are inherently stored and pg. 5: "Newtons can hold performance assessment databases.")
  - *where said assessment input information includes an assessment element, and where mapping said assessment input information to said rubric information includes mapping said assessment element to at least one matching benchmark included within said rubric information and further includes mapping said assessment input information to said at least one matching criteria and to said at least one matching score associated with said matching benchmark;* (pg. 4; "Utilizing...": "Following the activity or performance an individualized report to each student is easily printed with the students own score in each field")
  - *where storing the results of the mapping includes storing said matching score and any combination of said matching benchmark, said matching criteria, identification of said entity and of said rubric.* (pg. 4; "Utilizing...": "Following the activity or performance an individualized report to each student is easily printed with the students own score in each field", thus the "report" contains the stored mapped information.)
14. Stone further discloses that a rubric should be revised as necessary (pg. 4; "Recommendations...", but does not explicitly state creating a new benchmark within said rubric information during mapping of said assessment input information to said matching benchmark.

15. Trenholm, however, discloses that a user can make changes to the scoring rubric if the user determines that the rubric is flawed (C4; L27-34 and C11; L38-56) after which the changed rubric is used to rescore the item (i.e., the assessment input), thus as a final score is not produced until after the rubric is modified, the new benchmark is created during the mapping of the assessment input information.
16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included creating a new benchmark, as disclosed by Trenholm in the system disclosed by Stone, for the motivation of providing a method of ensuring that the rubric is pertinent to the activity or performance that is being assessed. As Stone discloses the need to revise the rubric, it is obvious to include a means to make the revisions, by Trenholm provides.
17. The Examiner further takes **Official Notice** that it is old and well known to make changes to or create new benchmarks, even during the collection of assessment data. For example, it is old and well known that students are assessed on oral presentation skills. It is also old and well known that some students have disabilities that impact their oral presentation skills, such as speech impediments. Therefore, it is obvious that a teacher would set a new or revised benchmark for a student with a known speech impediment during the student's presentation so as not to unfairly penalize the student. Perhaps the teacher would add a benchmark regarding eye-contact or posture in place of a benchmark regarding the nature of the speech mechanics. This is obvious to do so because Federal regulations would require the school to make a reasonable accommodation.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

/John G. Weiss/  
Supervisory Patent Examiner, Art Unit 3629